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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92051006
Party	Plaintiff Couch/Braunsdorf Affinity, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD**

COUCH/BRAUNSDORF AFFINITY, INC.,	:		
	:	Cancellation No.	92051006
Petitioner,	:		
	:	Mark:	PERKSPOT
v.	:		
	:	Registration No.	3,355,480
12 INTERACTIVE, LLC,	:		
	:	Registered:	December 18, 2007
Registrant.	:		

**PETITIONER’S ANSWER TO REGISTRANT’S  
COUNTERCLAIMS AND AFFIRMATIVE DEFENSES**

Couch/Braunsdorf Affinity, Inc. (“Petitioner”), hereby answers the counterclaims of 12 Interactive, LLC ) (“Registrant”). For the Board’s convenience, the allegations in Registrant’s counterclaims are repeated below and are then followed by Petitioner’s response.

**Counterclaims**

1. Registrant manages employee discount programs on behalf of Fortune 500 companies, state and local governments, and other large employers.

**RESPONSE TO COUNTERCLAIM NO. 1:**

Petitioner is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 1.

2. Since 2006, Registrant has done business under the name “Perkspot,” through the website <www.perkspot.com>. In accordance with this business, Registrant applied for and maintains U.S. Trademark Registration No. 3,355,480 (“Registrant’s Mark”) for use in connection with the administration of a program for enabling participants to obtain discounts from retailers and service providers.

**RESPONSE TO COUNTERCLAIM NO. 2:**

Petitioner admits that PTO records show Registrant applied for and owns U.S. Trademark Registration No. 3,355,480. Petitioner denies the remaining allegations in Paragraph 2.

3. Petitioner has petitioned to cancel Registrant's Mark, alleging that it is likely to cause confusion with U.S. Trademark Registration Nos. 1,786,961 ("PERKS 1"), 3,210,654 ("PERKS 2"), 2,580,914 ("PERKS CARD 1") and 3,156,685 ("PERKS CARD 2").

**RESPONSE TO COUNTERCLAIM NO. 3:**

Admitted.

4. On information and belief, Petitioner's applications filed in 2006 that matured into the PERKS 2 and PERKS CARD 2 registrations were initially rejected in light of the pre-existing PERKS 1 and PERKSCARD 1 registrations.

**RESPONSE TO COUNTERCLAIM NO. 4:**

Admitted.

5. On information and belief, Petitioner, in 2008 and subsequent to receiving office actions in response to its applications referenced in Paragraph No.4, acquired the PERKS 1 and PERKSCARD 1 registrations from a third party at least in part as a means to overcome the office actions.

**RESPONSE TO COUNTERCLAIM NO. 5:**

Denied.

**Count 1 – Certain Asserted Marks are Merely Descriptive**

6. The word "perk" is merely descriptive of a volume discount given to consumers in exchange for buying certain products or services.

**RESPONSE TO COUNTERCLAIM NO. 6:**

Denied.

7. The PERK 2 registration for use in connection with "providing volume discounts for consumer products and services via a magnetically controlled card" designates a service for which the associated mark is merely descriptive. Accordingly, the registration should have been refused registration in accordance with 15 U.S.C. § 1052(e)(1) and must be cancelled.

**RESPONSE TO COUNTERCLAIM NO. 7:**

Denied.

8. The term "perks card" is merely descriptive of a card used in association with perks.

**RESPONSE TO COUNTERCLAIM NO. 8:**

Denied.

9. The PERKSCARD 2 registration for use in connection with “providing volume discounts for consumer products and services,” *i.e.*, perks, is merely descriptive of a card which provides those designated services. Accordingly, the registration should have been refused registration in accordance with 15 U.S.C. § 1052(e)(1) and must be cancelled.

**RESPONSE TO COUNTERCLAIM NO. 9:**

Denied.

**Count II – Asserted Marks Are Generic**

10. The word “perk” has come to be known and used by the general public as a noun to define incentives or bonuses associated with conducting certain activities. Thus, “providing volume discount buying services” or “providing volume discounts for consumer products and services via a magnetically encoded card” would be perceived by the general public as providing “perks.”

**RESPONSE TO COUNTERCLAIM NO. 10:**

Denied.

11. Because “perk” is the commonly used term for the services offered in association with the PERKS 1 and PERKS 2 marks, these marks are incapable of source identification with respect to these services, and are therefore generic and free for all to use. Accordingly, the PERKS 1 and PERKS 2 marks should be cancelled and removed from the registry pursuant to 15 U.S.C. § 1064.

**RESPONSE TO COUNTERCLAIM NO. 11:**

Denied.

12. The term “perk card” has come to be known and used by the general public as a term to define a card used to distribute perks. The commonly used term to describe “volume discounts for consumer products and services” is “perks.” Thus, when such “buying services” or perks are offered through a card, the card is generically referred to as a “Perks Card.”

**RESPONSE TO COUNTERCLAIM NO. 12:**

Denied.

13. Because “Perks Card” is the common term for the services offered in association with the PERKSCARD 1 and PERKSCARD 2 marks, these marks are incapable of source identification with respect to these services, and are therefore generic and free for all to use.

**RESPONSE TO COUNTERCLAIM NO. 13:**

Denied.

### **Affirmative Defenses**

1. Registrant has not properly pleaded the basis for its purported counterclaims against Petitioner's marks. As a result, Registrant has failed to state a claim upon which relief can be granted. Fed. R. Civ. P. 12(b)(6). Petitioner pleads this affirmative defense against each of Registrant's purported counterclaims.

Dated this 14th day of September, 2009.

By:           /Philip A. Jones/            
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## **CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing  
PETITIONER'S ANSWER TO REGISTRANT'S COUNTERCLAIMS AND AFFIRMATIVE  
DEFENSES was served on counsel for Registrant by first class mail 14<sup>th</sup> day of September, 2009  
addressed as follows:

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/Philip A. Jones/